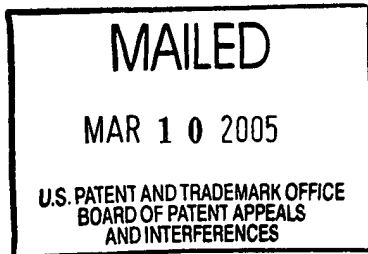


UNITED STATES PATENT AND TRADEMARK OFFICE



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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MELISA BUIE,  
BRIGITTE STOEHR and GUENTHER RUHL

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Application 10/024,958

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was electronically received at the Board of Patent Appeals and Interferences on February 25, 2005. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith electronically returned to the examiner. The matters requiring attention prior to docketing are identified below.

An examination of the file reveals that a supplemental Information Disclosure Statement (IDS) was filed April 15, 2004. It is not apparent from the record whether the examiner considered the statement submitted or notified appellants of why

their submission did not meet the criteria set forth in 37 CFR §§ 1.97 and 1.98. A communication notifying appellants of the Primary Examiner's decision is required.

A further examination of the record indicates that in the Final Rejection mailed March 18, 2004, the following § 103 rejection was made:

1. Claims 1-24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kornblit et al (US 5,948,570; hereinafter "Kornblut") in view of Mayer et al. (US 4,600,686; hereinafter "Meyer").

However, in the Examiner's Answer mailed December 1, 2004, the examiner lists the following rejection:

1. Claims 1-24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kornblit et al (US 5,948,570; hereinafter "Kornblut") in view of Mayer et al. (US 4,600,686; hereinafter "Meyer") as evidenced by Hasuzato et al. (US 5,750,290) and Demmim et al. (US 6,635,185).

It appears that the § 103(a) rejection of claims 1-24 listed above is a new ground of rejection.

On September 13, 2004, 37 CFR § 1.193 was abolished and replaced with 37 CFR § 41.39, which is reproduced below.

§ 41.39 Examiner's answer.

(a)(1) The primary examiner may, within such time as may be directed by the Director, furnish a written answer to the appeal brief including such explanation of the invention claimed and of the references relied upon and grounds of rejection as may be necessary, supplying a copy to appellant. If the primary examiner determines that the appeal does not comply with the provisions of §§ 41.31 and 41.37 or does not relate to an appealable action, the primary examiner shall make such determination of record.

(2) An examiner's answer may include a new ground of rejection.

(b) If an examiner's answer contains a rejection designated as a new ground of rejection, appellant must within two months from the date of the examiner's answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the new ground of rejection:

(1) Reopen prosecution. Request that prosecution be reopened before the primary examiner by filing a reply under § 1.111 of this title with or without amendment or submission of affidavits (§§ 1.130, 1.131 or 1.132 of this title) or other evidence. Any amendment or submission of affidavits or other evidence must be relevant to the new ground of rejection. A request that complies with this paragraph will be entered and the application or the patent under ex parte reexamination will be reconsidered by the examiner under the provisions of § 1.112 of this title. Any request that prosecution be reopened under this paragraph will be treated as a request to withdraw the appeal.

(2) Maintain appeal. Request that the appeal be maintained by filing a reply brief as set forth in § 41.41. Such a reply brief must address each new ground of rejection as set forth in § 41.37(c)(1)(vii) and should follow the other requirements of a brief as set forth in § 41.37(c). A reply brief may not be accompanied by any amendment, affidavit (§§ 1.130, 1.131 or 1.132 of this title) or other evidence. If a reply brief filed pursuant to this section is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under paragraph (b)(1) of this section.

(c) Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for ex parte reexamination proceedings.

An Examiner's Answer mailed after September 13, 2004, may include a new ground of rejection. In order to include a new ground of rejection in the Examiner's Answer, the examiner must follow the guidelines set forth in training material entitled "Rules of Practice Before the Board of Patent Appeals and Interferences, Final Rule," located at the following URL:

[www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html](http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html)

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The requirements for a new ground of rejection are:

1) Approval by a Technology Center Director or designee; and

2) Prominently identified, by a separate heading with all capital letters in the following sections of the Examiner's Answer:

Grounds of Rejection to be Reviewed on Appeal section, and

Grounds of Rejection section.

To correct this problem, the examiner will need to vacate the Examiner's Answer mailed December 2, 2004. Once the Examiner's Answer mailed December 2, 2004 is vacated, the examiner has the following options:

1) to write a new Examiner's Answer without the new grounds of rejection;

2) to reopen prosecution; or

3) to write a new Examiner's Answer properly setting forth the new grounds of rejection.

Accordingly, it is

ORDERED that the application is returned to the examiner:

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1. for consideration of the supplemental IDS filed April 15, 2004, and appropriate notification to appellants regarding the Primary Examiner's decision;
2. to vacate the Examiner's Answer mailed December 2, 2004;
3. to select one of the following options:
  - a) reopen prosecution;
  - b) write a new Examiner's Answer without the new grounds of rejection; or
  - c) write a new Examiner's Answer properly setting forth the new ground of rejection; and
4. for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

By: 

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dms/psb/meh